Remarks

Claims 1-21 are pending in the application. Claims 1-9 and 16-21 are subject to examination, claims 10-15 having been withdrawn from consideration as being not drawn to the elected species. The elected species is a method of treating an inflammatory disorder of the epithelial tissue comprising the administration of (R)-tofisopam, wherein the compound is administered as a dose of less than about 50 mg/day.

Claims 1-9 and 16-21 stand rejected. Reconsideration is respectfully requested in view of the following remarks.

Response to Obviousness-type Double Patenting Rejection

Pat. 6,864,251

Claims 1-9 and 16-21 have been rejected for obviousness-type double patenting over claims 1-12 of US. S. Pat. 6,864,251. Examiner alleges that the '251 patent claims and the present claims are not patentably distinct because the '251 patent claims a method of treating an individual afflicted with an inflammatory disorder mediated by LTB_4 while the present claims are directed to a method of treating an individual afflicted with an inflammatory disorder generally. Examiner alleges that the methods of claims 1-12 overlap in scope with the method of the present claims.

Examiner has mischaracterized the presently claimed invention. The invention is not directed to treatment of inflammatory disorders generally, but inflammatory disorders of epithelial tissue. More significantly, Examiner has overlooked the feature of claim 1 wherein the compound is administered at a dose of less than about 50 mg/day.

A non-statutory double patenting rejection must meet the requirements for an obviousness rejection under 35 U.S.C. § 103(a). MPEP 804(II)(B)(1). The examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The claims of the '251 patent do not suggest the feature where the compound is administered at a dose of less than about 50 mg/day . The rejection fails to establish a *prima facie* case a dose of less than about 50 mg/day is an obvious variant of any invention claimed in the '251 patent.

Examiner has not shown why it would have been obvious to a person of ordinary skill in the art to administer any compound of the '251 patent in the treatment of an inflammatory disorder of the epithelium at a dose of less than about 50 mg/day. Other than reciting "an effective amount" in claim 1, the claims of the '251 patent do not specify a dosage. Examiner has not explained how a dosage of less than about 50 mg/day is obvious over the recitation of "an effective amount" in the '251 patent claims. While not a limitation of the '251 patent claims, the relevant disclosure of the '251 patent regarding dosage teaches a range of 100 to 1500 mg/day. The low end of the range is twice the upper limit claimed in the present application. Those portions of a patent specification which provide support for the claims may be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. MPEP 804(II)(B)(1).

It is respectfully submitted that the claims of the present application are not obvious variants of the claims of the '251 patent. Reconsideration and allowance of the obviousness type double patenting rejection over the '251 patent is respectfully requested.

Application 10/727,940

Claims 1-9 and 16-21 have been provisionally rejected for obviousness-type double patenting over claims 1-6, 13-14 and 29-31 of application 10/727,940 ("'940 application"). Without acquiescing in the rejection, applicants defer response pending further disposition of the '940 application.

Other patents and applications

Examiner has made reference to patents and pending applications of the present assignee which are alleged to contain the same or similar subject matter. Examiner has invited applicants to review the subject matter of those properties and "submit the appropriate Terminal Disclaimer".

It is not a duty of a patent applicant to anticipate and respond to rejections not of record. Examiner has apparently reviewed at least a some of the referenced patents and patent

applications for purposes of double patenting, as double patenting rejections have been made in the instant office action. Should Examiner believe that further double patenting rejections are warranted, those rejections should be made in a further office action. A rejection for obviousness-type double patenting must present a fact-based analysis, which the Office is required to put on the record. Such a rejection must meet the requirements for an obviousness rejection under 35 U.S.C. § 103(a). MPEP 804(II)(B)(1).

A new obviousness-type double patenting rejections contained in a further office action would constitute a new ground of rejection, requiring such an action to be made non-final.

Response to Section 112 Rejection

Examiner alleges that the terminology "substantially free of the corresponding (*S*)-enantiomers" renders claim 16 indefinite. Examiner alleges that the terminology is not defined in the specification. This is incorrect. At page 29, line 6, "substantially free" of an enantiomer means that a composition contains at least 80% of the desired isomer, and therefore no more than 20% of the other enantiomer. Thus, claim 16 is not indefinite.

Response to Section 102 Rejection

Examiner alleges that claims 1 and 16-21 are allegedly anticipated by Ito. Ito reports pharmacologic studies of racemic tofisopam. By oral administration, the compound was observed to (i) inhibit spontaneous locomotion and acetic acid-induced stretching; (ii) decrease body temperature; and (iii) elevate pain threshold. The compound was hypotensive when administer to rabbits. The compound induced vasodilation *in vitro*. The compound inhibited adrenalin-induced arrhythmia and vasopressin-induced angina pectoris. At high concentrations, the compound relaxed isolated smooth muscle organs.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Vendegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). None of the biological effects of tofisopam reported by Ito indicate treatment of an inflammatory disorder of epithelial tissue.

Examiner makes specific reference to the elevation of pain thresholds. There is nothing in the disclosure of Ito that relates the observed increase in pain threshold to any effect involving inflammation, let alone an inflammatory disorder of the epithelium. There is nothing in the disclosure of Ito that teaches or suggests the use of tofisopam for the treatment of an inflammatory disorder of the epithelium.

The claims of the present application are further distinguished from Ito with respect to the administration dose. Claim 1 of the present application defines a method of treatment wherein a compound is administered at a dose of less than 50 mg/day. No dose information is given by Ito.

Ito fails to disclose each and every element as set forth in claim 1. Thus, claim 1, and its dependent claims, are not anticipated by Ito.

The dependent claims recite additional features that further distinguish over Ito. Ito fails to disclose a dosage of less than about 25 mg/day (claim 2), less than about 10 mg/day (claim 3), less than about 1 mg/day (claim 4), less than about 25 mg/ml (claim 5), and less than about 1 mg/ml (claim 6). Ito fails to disclose treatment of an inflammatory disorder of the epithelium which is a skin disorder (claim 7). Ito fails to disclose treatment of an inflammatory disorder of the epithelium which is a gastrointestinal disorder (claim 8). Ito fails to disclose intracolonic or topical administration (claim 9).

The Examiner makes reference to the claims as not describing the required degree of "substantially free of the corresponding (S)-enantiomers". The Examiner alleges that the expression would embrace a tofisopam racemate, as disclosed by Ito.

The quoted language appears in dependent claim 16. It is thus understood that Examiner's remarks in this regard are directed to claim 16.

As indicated above, the terminology "substantially free of the corresponding (S)-enantiomers" is defined in the specification and means that the compound comprises at least 80% of the desired isomer, and therefore no more than 20% of the other enantiomer. Claim 16 therefore is directed to a method wherein a compound which comprises at least 80% of the relevant (R)-enantiomer is administered. Claim 16 thus further distinguishes over Ito, which discloses only the racemate of tofisopam. The same as true of claims 17-21, which are directed to administration of (R)-enantiomers.

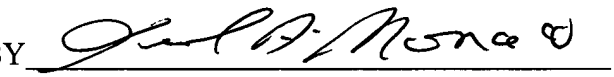
Accordingly, claims 1-9 and 16-21 are not anticipated by Ito. Reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

The claims remaining in the application are believed to be in condition for allowance. An early action toward that end is earnestly solicited.

Respectfully submitted,

STEVEN M. LEVENTER, *et al.*

BY 

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